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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,882	03/08/2002	Claudia Eder	02481.1779	1157

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EXAMINER

MARX, IRENE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

1551

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1) ☒ Responsive to communication(s) filed on 06 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) ☒ Claim(s) 1-8 is/are pending in the application.
4a) Of the above claim(s) 4-8 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-3 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

1) ☒ Notice of References Cited (PTO-892)

1) ☐ Interview Summary (DOT 112)

Applicant's election with traverse of Group I, claims 1-3 on 4/6/05 is acknowledged. The traversal is on the ground(s) that because serious burden is not involved all of the groups should be examined together.

For purposes of the initial restriction requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. No such showing or evidence has been provided. In addition, Applicants' sole point of argument that the search for the process of use involves a search of the method of making is not correct, since the compounds are old and have been made by diverse methods in the art. Similarly, various methods of use are also in the art. Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exists.

Clearly different searches and issues are involved with each group.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 3 are vague, indefinite and confusing in the recitation of "derivatives". The compounds intended as "derivatives" cannot be readily determined and it is unclear whether chemical or physiological derivatives are intended.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster *et al.* (U.S. Patent 6,316,476) or Chen *et al.* (WO 99/12543).

Each of the references discloses a method of treating a patient by administering an effective amount of a pharmaceutical composition comprising a compound of formula I. See, e.g., Webster *et al.*, col. 5 lines 1-27; Chen *et al.*, Example 3, page 11. Even though the compounds are shown to be effective to treat conditions which are not necessarily CNS disorders, the effects of treating the same patient with the same composition are inherent properties thereof. In order to qualify as an anticipatory reference, the disclosure need not be express. Even failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation: In *Atlas Powder Co. v. IRECO, Inc.*, 51 USPQ2d 1943 (Fed. Cir. 1999).

" To invalidate a patent by anticipation, a prior art reference normally needs to disclose each and every limitation of the claim." See *Standard Havens Prods., Inc. v. Gencor Indus., Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). However, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See *id.*; *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. See *Titanium Metals*, 778 F.2d at 780. Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. See *id.* at 782. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. See *id.* at

782 ("Congress has not seen fit to permit the patenting of an old [composition], known to others . . . , by one who has discovered its . . . useful properties."); *Verdegaal Bros.*, 814 F.2d at 633.

Therefore, the result of the same procedure by using the same compound is reasonably expected to be same. See *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993). The board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A US patent to Dart disclosed inoculation using *P. cepacia* bacteria for protecting the plant from fungal disease. Dart was silent with regard to nematode inhibition, but the Board concluded that nematode inhibition was an inherent property of the bacteria, and therefore of the method as disclosed by Dart.

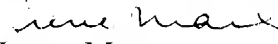
In the instant case, treatment of CNS disorders is an inherent property of the compounds of formula I and/or II.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Irene Marx
Primary Examiner
Art Unit 1651